UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,986	06/25/2003	Anthony J. Wasilewski	A-9233	3781

5642   7590   11/14/2006

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER
CHAI, LONGBIT

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	10/602,986	WASILEWSKI ET AL.
	Examiner	**Art Unit**	
	Longbit Chai	2131	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>30 October 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

    b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

       Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b)☐ They raise the issue of new matter (see NOTE below);

    (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

       NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed ~~amendment~~ claims(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: <u>1-22</u>.

    Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

CHRISTOPHER REVAK
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

As per claim 1 and 13, Applicant disagrees the objection to specification with the following remarks: based on "the original specification (i.e. (a) Provisional 60/054,578: Page 28 Line 25-28, and (b) SPEC: Page 27 Line 16 – 26). The paragraph of the cited provisional spanning from lines 19-28 on page 28 discusses each transport packet of a transport stream having a packet identifier. Lines 24-26 specifically state that a subcategory of information can thus be identified by the PID of its packets. As shown at output packets 707, the output from MUX704 is a sequence of individual packets from the various subcategories. Any part or all of MPEG-2 transport stream 701 may be encrypted." Examiner asserts Applicant's arguments are irrelevant because the objection is mainly directed to "Any part or all of MPEG-2 transport stream 701 may be encrypted" as disclosed by the provisional of specification and the instant application specification (see above), which does not support the claim limitation recited as selecting for encryption based on an packet identifier and the claims were amended to include "selecting for encryption based on an packet identifier" in the amendment filed August 1, 2006 and is not considered as part of the original disclosures.

Therefore, for clarity purpose, an additional 35 U.S.C. 112, 1st paragraph rejection of written description is presented along with the original 35 U.S.C. 102(b) rejection which is qualified to maintain the original status of FINAL rejection – See the attached "Advisory Final Rejection".

As per claim 1 and 13, Applicant asserts that Wasilewski does not teach selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier. Examiner respectfully disagrees because Wasilewski teaches (a) one or more bit streams of audio, video and data streams can be selected for encryption and besides, (b) each type of audio, video and data streams is uniquely assigned a packet ID (PID) and as such Wasilewski does teach selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier (Wasilewski: Figure 1 and Column 4 Line 65 – Column 5 Line 7 and Column 13 Line 65 – Column 14 Line 5) – at least this prior-art rejection is consistent with the original disclosure of the specification (i.e. Provisional 60/054,578: Page 28 Line 25-28 & SPEC: Page 27 Line 16 – 26) that indicates "A subcategory of information can thus be identified by the PID of its packets. As shown at output packets 707, the output from MUX704 is a sequence of individual packets from the various subcategories. Any part or all of MPEG-2 transport stream 701 may be encrypted". Therefore, "selecting for encryption based on an packet identifier" is not specifically supported by the original disclosures of the instant application and claim limitations.

Furthermore, claims 1 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 13 of copending Application No. 10/602,987 as a result of the amendment filed October 30, 2006 by the copending application to add the claim limitation "selecting for encryption using PID".

2

DETAILED ACTION

1.   Presently, pending claims are 1 – 22.

Response to Arguments

2.   Applicant's arguments with respect to the subject matter of the instant claims have been fully considered but are not persuasive.

3.   As per claim 1 and 13, Applicant disagrees the objection to specification with the following remarks: based on "the original specification (i.e. (a) Provisional 60/054,578: Page 28 Line 25-28, and (b) SPEC: Page 27 Line 16 – 26). The paragraph of the cited provisional spanning from lines 19-28 on page 28 discusses each transport packet of a transport stream having a packet identifier. Lines 24-26 specifically state that a subcategory of information can thus be identified by the PID of its packets. As shown at output packets 707, the output from MUX704 is a sequence of individual packets from the various subcategories. **Any part or all of MPEG-2 transport stream 701 may be encrypted**." Examiner asserts Applicant's arguments are irrelevant because the objection is mainly directed to "Any part or all of MPEG-2 transport stream 701 may be encrypted" as disclosed by the provisional of specification and the instant application specification (see above), which does not support the claim limitation recited as selecting for encryption based on an packet identifier and the claims were amended to include "selecting for encryption based on an packet identifier" in the amendment filed August 1, 2006 and is not considered as part of the original disclosures.

4.   Therefore, for clarity purpose, an additional 35 U.S.C. 112, 1st paragraph

rejection of written description is presented along with the original 35 U.S.C. 102(b)

rejection which is qualified to maintain the original status of FINAL rejection – See the

attached "Advisory Final Rejection".

5.   As per claim 1 and 13, Applicant asserts that Wasilewski does not teach

selecting for encryption a digital bit stream from a plurality of digital bit streams using an

identifier. Examiner respectfully disagrees because Wasilewski teaches (a) one or

more bit streams of audio, video and data streams can be selected for encryption and

besides, (b) each type of audio, video and data streams is uniquely assigned a packet

ID (PID) and as such Wasilewski does teach selecting for encryption a digital bit stream

from a plurality of digital bit streams using an identifier (Wasilewski: Figure 1 and

Column 4 Line 65 – Column 5 Line 7 and Column 13 Line 65 – Column 14 Line 5) – at

least this prior-art rejection **is consistent with** the original disclosure of the specification

(i.e. Provisional 60/054,578: Page 28 Line 25-28 & SPEC: Page 27 Line 16 – 26) that

indicates "A subcategory of information can thus be identified by the PID of its packets.

As shown at output packets 707, the output from MUX704 is a sequence of individual

packets from the various subcategories. Any part or all of MPEG-2 transport stream 701

may be encrypted". Therefore, "selecting for encryption based on an packet identifier"

is not specifically supported by the original disclosures of the instant application and

claim limitations.

6.   Furthermore, claims 1 and 13 are provisionally rejected under the judicially

created doctrine of obviousness-type double patenting as being unpatentable over

claims 1 and 13 of copending Application No. 10/602,987 as a result of the amendment

filed <u>October 30, 2006</u> by the copending application to add the claim limitation "selecting

for encryption using PID".

Objection

7.   The specification is objected to as failing to provide proper antecedent basis for

the claim amendment filed 8/1/2006 because <u>selecting for encryption using packet</u>

<u>identifier</u> is not specifically disclosed on the original specification (<u>Provisional</u>

<u>60/054,578: Page 28 Line 25-28 & SPEC: Page 27 Line 16 – 26</u>). See 37

CFR 1.75(d)(1) and MPEP § 608.01(o).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

8.   Claims 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to support the alleged

claim limitation "<u>selecting for encryption based on an packet identifier</u>". According to the

original disclosure of the specification (i.e. <u>Provisional 60/054,578: Page 28 Line 25-28</u>

<u>& SPEC: Page 27 Line 16 – 26</u>) that indicates "A subcategory of information can thus

be identified by the PID of its packets. As shown at output packets 707, the output from

MUX704 is a sequence of individual packets from the various subcategories. <u>Any part</u>

<u>or all of MPEG-2 transport stream 701 may be encrypted</u>". Therefore, "selecting for

encryption based on an packet identifier" is not specifically supported by <u>original</u>

<u>disclosures of the instant application and claim limitations</u> and the claims 1 and 13 were

amended to include "selecting for encryption <u>based on an packet identifier</u>" in the

amendment filed <u>August 1, 2006</u> and is not considered as part of the original

disclosures.

      Any other claims not addressed are also rejected accordingly by virtue of their

dependency.

Double Patenting

      The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*,

418 F.2d 528, 163 USPQ 644 (CCPA 1969).

      A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

Claims 1 and 13 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1 and 13 of

copending Application No. 10/602,987. Although the conflicting claims are not identical,

they are not patentably distinct from each other because claims 1 and 13 of the instant

application are envisioned by the claims of copending application that contain all the

limitations of claims of the instant application as a result of the amendment filed October

30, 2006 by the copending application to add the claim limitation "selecting for

encryption using PID" and as such are unpatentable for obvious-type double patenting.

This is a _provisional_ obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that

forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or
on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   Claims 1 – 22 are rejected under 35 U.S.C. 102(b) as being anticipated by

Wasilewski (U.S. Patent 5,418,782).

        As per claim 1 and 13, Wasilewski teaches a method for providing an instance

in a conditional access system, the method comprising the steps of:

        selecting for encryption a digital bit stream from a plurality of digital bit streams

using an identifier (Wasilewski: Figure 1 and Column 4 Line 65 – Column 5 Line 7 and

Column 13 Line 65 – Column 14 Line 5: (a) one or more bit streams of audio, video

and data streams can be selected for encryption and besides, (b) each type of audio,

video and data streams is uniquely assigned a packet ID (PID) and as such

Wasilewski does teach selecting for encryption a digital bit stream from a plurality of

digital bit streams using an identifier – at least this prior-art rejection **is consistent**

with the disclosure of the original specification (i.e. Provisional 60/054,578: Page 28

Line 25-28 & SPEC: Page 27 Line 16 – 26) that indicates "A subcategory of

information can thus be identified by the PID of its packets. As shown at output

packets 707, the output from MUX704 is a sequence of individual packets from the

various subcategories. Any part or all of MPEG-2 transport stream 701 may be

encrypted");

        encrypting the selected digital bit stream according to a first level encryption

method to provide an encrypted instance (Wasilewski: Column 4 Line 65 – 67: one or

more service components, such as video (V), audio (A), and data (CC) can be

encrypted / or not-encrypted prior to transmission – i.e., any part of transport stream

can be encrypted);

combining tire encrypted instance with the plurality of digital bit streams to

provide a partially-encrypted bit stream (Wasilewski: Figure 1 Element 16 and Column

4 Line 65 – 67), and

transmitting the partially -encrypted bit stream (Wasilewski: Figure 1 Element 16

and Column 5 Line 4 – 15: by multiplexing the service component bit streams).

As per claim 2, 4, 14 and 15, Wasilewski teaches each of the plurality of digital

bit streams includes a packet identifier, and wherein the selecting step selects the

digital bit stream by identifying a predetermined packet identifier (Wasilewski: Column

13 Line 57 – Column 14 Line 16 and Figure 1 Element 16).

As per claim 3, Wasilewski teaches all of the selected digital bit stream is

encrypted according to the first level encryption method (Wasilewski: Column 4 Line

65 – 67: one or more service components, such as video (V), audio (A), and data (CC)

can be encrypted / or not-encrypted prior to transmission – i.e., any part of transport

stream can be encrypted).

As per claim 5, Wasilewski teaches a portion of the selected digital bit stream is

encrypted, wherein the encrypted portion and an unencrypted portion of the selected

digital stream are combined with the plurality of digital bit streams (Wasilewski:

Column 4 Line 65 – 67: one or more service components, such as video (V), audio

(A), and data (CC) can be encrypted / or not-encrypted prior to transmission – i.e., any

part of transport stream can be encrypted).

As per claim 6, Wasilewski teaches the selected digital bit stream is a program

(Wasilewski: Column 13 Line 57 – Column 14 Line 16).

As per claim 7, Wasilewski teaches the selected digital bit stream is an

elementary digital bit stream (Wasilewski: Column 13 Line 57 – Column 14 Line

16).

As per claim 8, Wasilewski teaches selecting more than one digital bit stream

from the plurality of digital bit streams, wherein the more than one digital bit stream is

identified by predetermined packet identifiers (Wasilewski: Column 13 Line 57 –

Column 14 Line 16 and Figure 1).

As per claim 9, Wasilewski teaches each of the more than one digital bit

stream includes a distinct packet identifier, wherein the selecting step selects the

more than one digital bit stream by identifying at least one of the distinct packet

identifiers (Wasilewski: Column 13 Line 57 – Column 14 Line 16 and Figure 1).

As per claim 10, Wasilewski teaches a portion of each of the more than one

digital bit stream is encrypted according to the first level encryption method

(Wasilewski: Column 4 Line 65 – 67: one or more service components, such as video

(V), audio (A), and data (CC) can be encrypted / or not-encrypted prior to

transmission – i.e., any part of transport stream can be encrypted).

As per claim 11, Wasilewski teaches all of the more than one digital bit stream

is encrypted according to the first level encryption method (Wasilewski: Column 4

Line 65 – 67: one or more service components, such as video (V), audio (A), and

data (CC) can be encrypted / or not-encrypted prior to transmission – i.e., any part of

transport stream can be encrypted).

As per claim 12, Wasilewski teaches at least one of a portion of each of the

more than one digital bit stream and all of the more than one digital bit stream is

encrypted according to the first level encryption method (Wasilewski: Column 4 Line

65 – 67: one or more service components, such as video (V), audio (A), and data

(CC) can be encrypted / or not-encrypted prior to transmission – i.e., any part of

transport stream can be encrypted).

As per claim 16, Wasilewski teaches the encrypted portion includes at least one

of the plurality of packets associated with the video stream (Wasilewski: Column 4

Line 65 – 67 and Figure 1).

As per claim 17, Wasilewski teaches the at least one of the plurality of packets

is selected by the packet identifier indicative of the video stream (Wasilewski: Column

13 Line 57 – Column 14 Line 16 and Column 4 Line 65 – 67 and Figure 1).

As per claim 18, Wasilewski teaches the encrypted portion includes at least one of plurality of packets associated with the audio stream (Wasilewski: Column 13 Line 57 – Column 14 Line 16 Column 4 Line 65 – 67 and Figure 1).

As per claim 19, Wasilewski teaches the at least one of the plurality of packets is selected by the packet identifier indicative of the audio stream (Wasilewski: Column 13 Line 57 – Column 14 Line 16 Column 4 Line 65 – 67 and Figure 1).

As per claim 20, Wasilewski teaches the encrypted portion includes at least one of the plurality of packets associated with the data stream (Wasilewski: Column 13 Line 57 – Column 14 Line 16 Column 4 Line 65 – 67 and Figure 1).

As per claim 21, Wasilewski teaches the at least one of the plurality of packets is selected by the packet identifier indicative of the data stream (Wasilewski: Column 13 Line 57 – Column 14 Line 16 Column 4 Line 65 – 67 and Figure 1).

As per claim 22, Wasilewski teaches the encrypted portion includes at least one of the plurality of packets associated with at least one of the video stream, the audio stream, and the data stream (Wasilewski: Column 13 Line 57 – Column 14 Line 16 Column 4 Line 65 – 67 and Figure 1).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Longbit Chai whose telephone number is 571-272-3788.

The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

                                                    Longbit Chai
                                                    Examiner
                                                    Art Unit 2131

LBC

CHRISTOPHER REVAK
PRIMARY EXAMINER